

Remarks

Claims 1-4, 7-11, 30, 31, 34-36, 42, 43, 49, 55, 59, and 64 are pending in the application. Claims 1 and 42 have been amended in a good faith effort to place the claims in condition for allowance by incorporating the subject matter of Claims 2, 3, 33, and 34 into Claim 1 and by incorporating the subject matter of Claim 7 into Claims 1 and 42. Consequently, Claims 2, 3, 7, 33 and 34 have been cancelled without prejudice or without admitting anticipation or obviousness. Claims 8 and 35 have been amended to provide proper antecedent basis.

Entry of the Amendment is respectfully requested to advance the prosecution of this case to allowance and to narrow the issues between Applicants and the Examiner in the event of appeal.

§112 Rejections

I. Claims 1-4, 7-11, 30, 31, 34-36, 42, 43, 49, 55, 59 and 64 were rejected under USC §112, first paragraph for non-enablement over the scope of the claims.

Examiner asserts that the claims as a whole are enabling for compounds wherein R¹ and R⁰ and aryl(phenyl) with halogen or methoxy substituents or R⁴ is an alkyl, halo-substituted alkyl, or cycloalkyl, but not enabled for the other substituents. Firstly, Examiner ignored the example illustrating a cyano-substituted phenyl (Ex. No. 1A-2). More importantly, Examiner appears to be restricting Applicants invention to only those compounds specifically exemplified which is totally improper. It has never been the law that an Applicant is restricted to only those compounds exemplified in the specification. In fact, there is no requirement that any examples be present. One must only provide sufficient teaching to allow one of skill in the art to practice the invention. Controlling precedent requires that the US PTO accept the objective truth of Applicants' teachings of enablement unless there is a reason to doubt these teachings. Applicants respectfully submit that there is no reason to doubt the objective truth of the statements contained within the Specification upon which Applicants rely for enabling support.

As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing the defining the subject matter sought to be patented must be taken as in compliance with the enabling

requirement of the first paragraph of §112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for the enabling support. In Re Marzocchi, 439 F.2d 220,222 (CCPA 1971).

The burden is on the Examiner to come forward with evidence as to why assertions of utility should not be accepted. In the instant case, the Examiner has merely made conclusory statements from general references without any specific evidence why Applicant's assertions should not be accepted as true. Examiner has totally ignored the references cited in the IDS which establish the present skill of the art. For example, Applicants can rely on earlier work by the same assignee to support the additional substituents. See, e.g., US 7,129,239 (Pfizer, Inc.) which describes numerous R⁰ and R¹ substituents. Without specific evidence refuting the state of the art, the rejection of the specification/claims under 35 USC §112, 1st paragraph for lack of enablement is contrary to well established law.

Applicants respectfully submit that the amended claims and the claims dependent thereon are in condition for allowance.

Respectfully Submitted:

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